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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,310	12/12/2003	Tomohiro Shinoda	LIL-0002	9083
23353	7590	10/06/2006	EXAMINER	
RADER FISHMAN & GRAUER PLLC LION BUILDING 1233 20TH STREET N.W., SUITE 501 WASHINGTON, DC 20036			LEUNG, JENNIFER	
			ART UNIT	PAPER NUMBER
			3709	

DATE MAILED: 10/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/733,310	SHINODA, TOMOHIRO	
	Examiner	Art Unit	
	Jennifer Leung	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-8 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 12/12/2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 5/4/2004 and 3/16/2005.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to because the top of trading card 20c should be labeled -- Scorpion --, not "Saturn".

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. The abstract of the disclosure is objected to because of the inclusion of legal phraseology, "means" in lines 2, 3, and 6. Further, the first sentence has been drafted as a long run-on sentence, much like claim 1, which is improper. The abstract should be in narrative and should consist of a series of complete sentences forming a single paragraph.

Correction is required. See MPEP § 608.01(b).

4. The disclosure is objected to because of the following informalities:

Page 9, line 1: "trading card" should be -- trading cards --.

Page 11, line 7: "display monitor 26" should be -- display monitor 14 --.

Page 12, line 4: "CPU 40" should be -- CPU 41 --.

Page 15, lines 6-8: "a trading card in which ... will be paid out" is difficult to comprehend. The phrase should be reworded.

Page 17, line 1: "from the trading card, for example" should be eliminated.

According to the first part of the sentence, there is no trading card in the trading card slot.

Page 19, line 14: "Fig.6" should be -- Fig. 5 --.

Appropriate correction is required.

### ***Claim Objections***

5. Claim 8 is objected to because of the following informalities:

Claim 8, lines 6-7: "the read character data" should be -- the character data read by the card reader -- in order to be consistent with the claim language as recited in claim 7, lines 11-12.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 4 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in

the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The limitation, "selecting means for selecting" in claim 4, line 2 is understood to be a means plus function claim under 35 USC 112, paragraph 6. However, "selecting means" is not adequately described in the specification on page 23, lines 5-12. To select a reward trading card among a plurality of trading cards, a computer program appears to be implemented to enable such a selection. However, under 35 USC 101, computer programs themselves are not patentable subject matter.

Appropriate correction is required.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite because it is not clear as to whether the payout means encompasses the data reading means (see specification page 19, lines 14-19), or that the data reading means is a separate electronic device from the payout means. For the rejections below, the examiner assumes that the data reading means is a separate device from the payout means.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1, 2, 3, 5, 6 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakamura (US 6,468,162).

Re claim 1: Nakamura discloses a gaming machine comprising data reading means for reading character data from at least one inserted trading card (col. 6, lines 35-39); and payout means for paying out at least one reward trading card (72) (see Fig. 3A; col. 13, lines 18-19), wherein the at least one reward trading card stores updated character data on a basis of both a status of a game and the character data read by the data reading means (col. 4, lines 5-8; col. 9, lines 54-56; col. 10, lines 23-27).

Re claim 2: Nakamura further discloses a payout means, which pays out the at least one inserted trading card as the at least one reward trading card (68, 70) (see Fig 3A; col. 15, lines 2-4: if the character information of the inserted memory card is updated, then the same card is used as the reward trading card).

Re claim 3: Nakamura further discloses the payout means that includes writing means for writing the updated character data in the at least one reward trading card (col. 6, lines 25-28).

Re claim 5: Nakamura further discloses the character data, which includes capability and attribute values (col. 6, lines 17-25).

Re claim 6: Nakamura further discloses the payout means (col. 13, lines 18-19) that includes printing means for printing an image on a surface of the at least one reward trading card (col. 13, lines 11-13).

Re claim 8: Nakamura discloses a method for controlling a gaming machine including a card reader (col. 6, lines 35-39) and a card writer (col. 6, lines 25-28), comprising: reading character data from at least one inserted trading card (col. 6, lines 35-37); advancing a game based on the character data (col. 6, lines 44-51; col. 9, lines 32-33); and writing updated character data to at least one reward trading card, the updated character data being on a basis of both a status of the game and the read character data (col. 4, lines 5-8; col. 9, lines 54-56; col. 10, lines 23-27).

12. Claims 7 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Muroi (US 2002/0052238).

Re claim 7: Muroi discloses a gaming machine comprising a card reader which reads character data from at least one inserted trading card (claim 1, lines 13-17); a card writer which writes updated character data on at least one reward trading card (claim 1, lines 13-15; paragraph 0039, lines 3-6); and a controller (11: CPU, which functions as a controller) which executes a predetermined computer program (pg. 5, right col., claim 8, lines 1-4), the controller (11) being connected to the card reader and the card writer (Fig. 1: the CPU is connected to the reader/writer through the data/address bus (1K) and the transmission/reception interface), wherein the controller causes the card reader to read the character data from the at least one inserted trading card (claim 8, lines 1-7), causes a game to advance on a basis of the character data read by the card reader (claim 8, lines 11-14), and causes the card writer to write the updated character data on a basis of both a status of the game and the character data read by the card reader (claim 8, lines 16-18; claim 4, lines 5-9).

Re claim 8: Muroi discloses a method for controlling a gaming machine including a card reader (claim 1, lines 13-17) and a card writer (claim 1, lines 13-15), comprising: reading character data from at least one inserted trading card (claim 8, lines 5-7); advancing a game based on the character data (claim 8, lines 11-14); and writing updated character data to at least one reward trading card, the updated character data being on a basis of both a status of the game and the read character data (claim 8, lines 16-18; claim 4, lines 5-9).

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura in view of Buckley (US 5,036,472). The teachings of Nakamura have been discussed above.

However, Nakamura fails to disclose or fairly suggest the selecting means for selecting the at least one reward trading card among a plurality of trading cards stocked in the gaming machine. Buckley teaches a selecting means for selecting a card form among a plurality of forms stocked in a machine (Fig. 4; col. 6, lines 21-22; col. 1, lines 46-54).

Therefore, in view of Buckley, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a selecting means for selecting a card to Nakamura's gaming machine in order to allow selection of a particular reward trading card from a stack of cards with character data stored in advance instead of having to update character data and reprint an image on the inserted trading card.

***Conclusion***

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Peppel discloses an electronic trading card. Grady discloses a card reader and scanner device and methods of using the same. Pearson discloses a video sports game system using trading cards. Siegel discloses an electronic gaming method using coded input data. Swanberg discloses interactive computer games. Weston discloses a method of game play using an RFID tracking device. Kawahara discloses a card for game and for trade, and its operation system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Leung whose telephone number is 571-270-1342. The examiner can normally be reached on Mon -Thur, every other Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jong-Suk (James) Lee can be reached on 571-272-7044. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*JL*  
Jennifer Leung  
September 26, 2006



JONG SUK LEE  
SUPERVISORY PATENT EXAMINER